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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,290	08/18/2003	Colin Charles Owen Goble	978-72	2016
23117	7590	04/25/2006	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			PEFFLEY, MICHAEL F	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/642,290	GOBLE, COLIN CHARLES OWEN	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 20 January 2006.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-5 and 11-18 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-5 and 11-18 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 20 January 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1/20/06</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

**DETAILED ACTION**

***Response to Amendment***

1. In response to the Amendment filed on January 20, 2006, amended claims 1, 12, 15 and 17, formal drawings, amendments to the specification and new claim 18 are acknowledged.
2. Claims 1, 5 and 18 are *newly* rejected under 35 U.S.C. 103(a) as being unpatentable over Denen et al. (U.S. Patent No. 5400267) in view of Hareyama et al. (U.S. Patent No. 6306131). Claims 2-4 and 17 are *newly* rejected under 35 U.S.C. 103(a) as being unpatentable over Denen et al. in view of Hareyama et al., further in view of Klett et al. (German Patent Application No. 4339049). Claims 11 and 14 are *newly* rejected under 35 U.S.C. 103(a) as being unpatentable over Denen et al. in view of Hareyama et al., further in view of Roos (U.S. Patent No. 5269780). Claims 12, 13, 15 and 16 are *newly* rejected under 35 U.S.C. 103(a) as being unpatentable over Denen et al. in view of Hareyama et al., further in view of Latterell et al. (U.S. Patent No. 6808525).

***Allowable Subject Matter***

3. The indicated allowability of claims 12, 13, 15 and 16 are withdrawn in view of the newly discovered reference(s) to Latterell et al. Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1, 5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Denen et al. (U.S. Patent No. 5400267) in view of Hareyama et al. (U.S. Patent

No. 6306131).

- a. In regards to Claim 1, Denen et al. discloses an electrosurgical system comprising "a generator for generating RF power" (See Denen et al. Figure 3, element 32), "electrosurgical instrument including at least two electrodes" (See Denen et al. Figure 3, element 31), "an identification element carried by the instrument and being representative of at least the number of electrodes present on the instrument" (See Denen et al. Figure 3, element 30; see also col. 8, lines 47-68), "an RF output stage having at least pair of RF output lines" (See Denen et al. Figure 3, element 34), "a power supply coupled to the output stage for supplying power to the output stage" (See Denen et al. Figure 3, element 39), "a controller capable of varying an RF signal supplied to the RF output lines" (See Denen et al. Figure 3, element 36) and "a sensing circuit adapted to sense the

identification element carried by the instrument" (See Denen et al. Figure 3, element 35).

Denen et al. does not disclose "a switching circuit having at least three output connections, each of at least two of which being in electrical connection with a respective one of the at least two electrodes". Attention is directed to the Hareyama et al. reference which in an analogous field of endeavor teaches the use of a switching device to provide power to selected electrodes (See Hareyama et al. col. 19, lines 13-46). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the system of Denen et al. with the switching device as taught by Hareyama et al. to automatically perform a cutting treatment after a coagulation treatment without intervention by the operator.

b. In regards to Claim 5, Denen et al. in view of Hareyama et al. discloses an electrosurgical system (See Claim 1 Rejection). Denen et al. in view of Hareyama et al. further discloses "the controller is such as to adjust automatically the RF power supplied to at least one of the three or more output connections to limit the peak generator output voltage to at least a first value when a first combination of electrodes is selected by the switching circuit, and to at least a second value when a second combination of electrodes is selected by the switching circuit" (See Hareyama et al. col. 19, lines 13-46).

c. In regards to Claim 18, Denen et al. in view of Hareyama et al. discloses an electrosurgical system (See Claim 1 Rejection). Denen et al. in view of

Hareyama et al. further discloses "at least two of the switching circuit's output connections are electrically connected to one another" (See Hareyama et al. col. 19, lines 13-46).

9. Claims 2-4, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denen et al. in view of Hareyama et al. as applied to claim 1 above, and further in view of Klett et al. (German Patent Application No. 4339049).

a. In regards to Claims 2-4, Denen et al. in view of Hareyama et al. discloses an electrosurgical system (See Claim 1 Rejection). Denen et al. in view of Hareyama et al. does not discloses "the identification element is a resistor", "the sensing circuit is adapted to sense the resistance of the identification element", "the identification element is a capacitor, and the sensing circuit is adapted to sense the capacitance of the identification element", "the sensing circuit includes an inductor such as to form a resonant circuit with the identification element, the sensing circuit being adapted to determine the resonant frequency of the resonant circuit so as to identify the identification element".

Attention is directed to the Klett et al. reference, which in an analogous field of endeavor discloses electrosurgical devices with a coding element in the form of a resistor, capacitor or inductor (See Klett et al. page 5, line 10 – page 6, line 12). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the identification element of Denen et al. in view of Hareyama et al. with the coding element of Klett et al to provide an alternate method of providing an identification element on an electrosurgical device. It is

the Examiner's position that Klett et al. does not explicitly say the sensing circuit is adapted to sense the resistance, capacitance or inductance of the identification element but, it is understood that the sensing circuit must be inherently configured to sense the resistance, capacitance or inductance in view of the teaching of Klett et al. that the identification element can be a resistor, a capacitor or an inductor.

b. In regards to Claim 17, Denen et al. discloses an apparatus comprising "a generator for generating RF power" (See Denen et al. Figure 3, element 32), , "each of the plurality of electrosurgical instruments having an identification element carried by the instrument and being representative of at least the number of electrodes present on the instrument" (See Denen et al. Figure 3, element 30; see also column 8, lines 47-68), "an RF output stage having at least pair of RF output lines" (See Denen et al. Figure 3, element 34), "a power supply coupled to the output stage for supplying power to the output stage" (See Denen et al. Figure 3, element 32), "a controller capable of varying an RF signal supplied to the RF output lines" (See Denen et al. Figure 3, element 36), and "a sensing circuit adapted to sense the identification element carried by the instrument" (See Denen et al. Figure 3, element 35).

Denen et al. does not disclose "a switching circuit having at least three output connections, each of at least two of which being in electrical connection with a respective one of the at least two electrodes". Attention is directed to the Hareyama et al. reference which in an analogous field of endeavor teaches the

use of a switching device to provide power to selected electrodes (See Hareyama et al. col. 19, lines 13-46). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the system of Denen et al. with the switching device as taught by Hareyama et al. to automatically perform a cutting treatment after a coagulation treatment without intervention by the operator.

Denen et al. in view of Hareyama et al. does not disclose "a plurality of electrosurgical instruments, the plurality of electrosurgical instruments including at least one electrosurgical instrument having two electrodes, and at least one electrosurgical instrument having at least three electrodes". Attention is directed to the Klett et al. reference, which in an analogous field of endeavor discloses an electrosurgical generator system capable of connecting multiple electrosurgical devices (See Klett et al. Figure 5 and 6; see also page 10, line 20 – page 11, line 21). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the generator system of Klett et al. to the generator of Denen et al. in view of Hareyama et al. to have an electrosurgical generator that enables an operator to use multiple electrosurgical devices simultaneously.

8. Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denen et al. in view of Hareyama et al. as applied to claim 1 above, and further in view of Roos (U.S. Patent No. 5269780).

a. In regards to Claim 11, Denen et al. in view of Hareyama et al. disclose an apparatus (See Claim 1 Rejection).

Denen et al. in view of Hareyama et al. does not disclose, "at least one of the electrodes is in the form of a hook". Attention is directed to the Roos reference, which in an analogous field of endeavor discloses an electrosurgical apparatus utilizing electrodes in the form of needles or hooks (See Roos Figure 2; see also col. 1, lines 21-33 and col. 3, line 64 – col. 4, line 11). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Denen et al. in view of Hareyama et al. with the hook structure of Roos to provide a cutting and coagulating electrosurgical device for laparoscopic surgery.

b. In regards to Claim 14, Denen et al. in view of Hareyama et al. disclose an apparatus (See Claim 1 Rejection).

Denen et al. in view of Hareyama et al. does not disclose, "at least three of the electrodes are each in the form of a hook". Attention is directed to the Roos reference, which in an analogous field of endeavor discloses an electrosurgical apparatus utilizing three electrodes to cut and coagulate tissue (See Roos Figures 3 and 4; see also col. 4, lines 54-60 and col. 5, lines 25-37). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Denen et al. in view of Hareyama et al. with the hook structure of Roos to provide an alternative structure for a cutting and coagulating electrosurgical device for laparoscopic surgery.

9. Claims 12, 13, 15 and 16 are rejected under 35 U.S.C. 103(a) as being obvious over Denen et al. in view of Hareyama et al., further in view of Latterell et al. (U.S. Patent No. 6808525).

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

a. In regards to Claims 12 and 15, Denen et al. discloses an electrosurgical system comprising “a generator for generating RF power” (See Denen et al. Figure 3, element 32), “and electrosurgical instrument including at least two electrodes” (See Denen et al. Figure 3, element 31), “an identification element carried by the instrument and being representative of at least the number of

electrodes present on the instrument" (See Denen et al. Figure 3, element 30), "an RF output stage having at least pair of RF output lines" (See Denen et al. Figure 3, element 34), "a power supply coupled to the output stage for supplying power to the output stage" (See Denen et al. Figure 3, element 32), "a controller capable of varying an RF signal supplied to the RF output lines" (See Denen et al. Figure 3, element 36) and "a sensing circuit adapted to sense the identification element carried by the instrument" (See Denen et al. Figure 3, element 35).

Denen et al. does not disclose "a switching circuit having at least three output connections, each of at least two of which being in electrical connection with a respective one of the at least two electrodes". Attention is directed to the Hareyama et al. reference which in an analogous field of endeavor teaches the use of a switching device to provide power to selected electrodes (See Hareyama et al. col. 19, lines 13-46). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the system of Denen et al. with the switching device as taught by Hareyama et al. to automatically perform a cutting treatment after a coagulation treatment without intervention by the operator.

Denen et al. in view of Hareyama et al. does not disclose "wherein at least one of the electrodes being in the form of a hook, at least one hook electrode extending distally beyond the other electrodes" and "wherein at least one of the electrodes is longitudinally movable such that it can be extended and retracted

with respect to the other electrodes". Attention is directed to the Latterell et al. reference, which in an analogous field of endeavor discloses a hook-like electrode, which is movable beyond two spherical electrodes (See Latterell et al. col. 4, lines 20-57). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Denen et al. in view of Hareyama et al. with the electrodes of Latterell et al. to provide enhanced cutting and coagulation capability over existing hook-probe instruments.

b. In regards to Claims 13 and 16, Denen et al. in view of Hareyama et al. further in view of Latterell et al. discloses an electrosurgical system (See Claims 12 and 15 Rejection). Denen et al. in view of Hareyama et al. further in view of Latterell et al. further discloses "wherein there is a centrally positioned electrode extending distally beyond the other electrodes" and "wherein the longitudinally movable electrode is positioned centrally between the other electrodes" (See Latterell et al. Figure 2A).

***Response to Arguments***

10. Applicant's arguments with respect to claims 1-5 and 11-18 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth C. Williams whose telephone number is (571) 272-8161. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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